

PATENT

Atty Docket No.: 200313187-1

App. Ser. No.: 10/758,228

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the claim amendments and following remarks.

By virtue of the amendments above, Claims 1, 7-10, 12, 13, and 15-17 have been amended and Claim 11 has been canceled without prejudice or disclaimer of the subject matter contained therein. In addition, Claims 50-60 have been added and Claims 18-49 have been withdrawn from consideration as being drawn to a non-elected species. Accordingly, Claims 1-10, 12-18 and 50-56 are pending in the present application, of which Claims 1, 50, and 56 are independent.

No new matter has been introduced by way of the claim amendments; entry thereof is therefore respectfully requested.

Drawings

The Official Action fails to indicate whether the drawings submitted on January 23, 2004 have been accepted by the Examiner. However, because the Official Action does not include any specific objections to the drawings, the drawings are believed to have been accepted. Should this assumption be in error, the Examiner is respectfully requested to inform the Applicants in a future correspondence.

Information Disclosure Statement

The indication that the documents cited in the Information Disclosure Statement submitted on January 16, 2004 have been considered is noted with appreciation.

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Claim Objections

The claims have been amended in minor respects to clarify Claims 7-9 and 15-17.

Accordingly, withdrawal of the claim objections is respectfully requested.

Claim Rejection Under 35 U.S.C. §112, second paragraph

The Official Action sets forth a rejection of Claims 7-9 and 15-17 as allegedly being indefinite for reciting the terms "such as". By virtue of the amendments above, Claims 7 and 15 have been amended to remove those terms and to better comply with the provisions of 35 U.S.C. §112, second paragraph. Accordingly, withdrawal of the claim rejections is respectfully requested.

Claim Rejection Under 35 U.S.C. §102

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

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Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

Claims 1-4, 6, and 10-12 have been rejected under 35 U.S.C. §102(b) as allegedly being unpatentable over the disclosure contained in U.S. Patent No. 5,263,476 to Eguchi et al. For at least the following reasons, it is respectfully submitted that this rejection is clearly improper and should be withdrawn.

Independent Claim 1 has been amended to include, *inter alia*, that the storage medium contains an electrode, an electrolyte layer positioned on the electrode, and a conductive layer positioned on the electrolyte layer, wherein the conductive layer is positioned between the at least one probe and the electrolyte layer. The conductive layer was recited in now canceled Claim 11 and is shown at least in Figure 3.

In rejecting Claim 11, the Official Action asserted that column 14, lines 49-54 of Eguchi et al. "teaches the device according to claim 3 as set forth above, wherein the storage medium further comprises: a conductive layer positioned on the electrolyte layer, wherein the at least one probe is configured to contact the conductive layer." (Official Action, page 4, last paragraph). A close inspection of the discussion contained in column 14, lines 49-54 of Eguchi et al. clearly reveals, however, that Eguchi et al. fails to disclose a conductive layer positioned on an electrolyte layer as claimed in Claim 1 of the present invention.

The disclosure contained in column 14, lines 49-54 of Eguchi et al. indicates that a "metal electrode" is required under certain circumstances. The Official Action apparently asserts that "metal electrode" discussed here is equivalent to the claimed conductive layer. This assumption is incorrect, however, because in lines 35-48 of column 14, Eguchi et al.

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indicates that the "electrode material" may include metals and thus, the "metal electrode" is the same as the electrode 103, when the electrode 103 includes a metal. As such, and as depicted in Figure 1, Eguchi et al. shows that the electrode 103 is positioned on top of the substrate 104 and that a recording layer 101 is positioned on top of the electrode 103. Accordingly, Eguchi et al. fails to show or disclose that the electrode 103 is positioned on top of the recording layer 101.

For at least the foregoing reasons, it is respectfully submitted that Eguchi et al. fails to disclose each and every element claimed in independent Claim 1 of the present invention and therefore cannot anticipate this claim. The Examiner is therefore respectfully requested to withdraw this rejection and to allow Claim 1 and the claims that depend therefrom.

Claim Rejection Under 35 U.S.C. §103

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

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Claims 5, 7-9, and 13-17 have been rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 5,623,476 to Eguchi et al. in view of U.S. Patent Application Publication Serial No. 2005/0122757 to Moore et al. This rejection is respectfully traversed for at least the following reasons.

The Official Action correctly identifies a number of claimed features that are not disclosed or suggested in Eguchi et al. In an effort to make up for these deficiencies in Eguchi et al., the Official Action relies upon the disclosure contained in Moore et al. For instance, with respect to Claim 13, the Official Action asserts that Moore et al. discloses "a plurality of discrete conductive elements spaced apart from each other discontinuously (fig. 11), wherein the plurality of conductive elements are associated with memory cells (pg. 4, [0050]-[0051])." (Official Action, page 8, second paragraph). The Official Action has apparently interpreted the first electrode 114 of Moore et al. as being equivalent to the claimed conductive layer. In addition, the Official Action has asserted that Eguchi et al. and Moore et al. could somehow be combined to disclose the claimed invention as set forth in Claim 13.

More particularly, the Official Action states that "it would have been obvious...to modify the device of Eguchi with the teaching of Moore, to have the conductive layer comprised of a plurality of conductive elements, which are associated with memory cells, for the purpose of using the memory cells in programmable conductive memory elements, thus improving power consumption and enhancing the speed of devices with the memory components (pg. 1, [0008])." (Official Action, page 8, third paragraph). This assertion is clearly improper for at least the following reasons.

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Initially, and as described above, the purported "conductive layer" of Eguchi et al. comprises the electrode 103, which Eguchi et al. discloses as being positioned underneath of the recording layer 101. As such, even if one of ordinary skill in the art were somehow motivated to modify Eguchi et al. to include the first electrode 114 of Moore et al., the proposed combination would not cause the first electrode 114 of Moore et al. to be positioned on top of the recording layer 101. Instead, at best, the proposed combination would cause the electrode 103 to be formed of discrete electrodes.

In addition, because Moore et al. discloses that the first electrode 114 is used to apply various voltages to the cell 110 (see page 3, par. [0038]), the proposed combination would defeat the purpose of having the probe electrode 102 in Eguchi et al. That is, because the probe electrode 102 in Eguchi et al. performs the same functions as the first electrode 114 of Moore et al., such as addressing cells 110, the addition of the first electrode 114 as suggested in the Official Action would render the probe electrode 102 obsolete. For at least this reason, the proposed combination of Eguchi et al. and Moore et al. is improper and should be withdrawn.

Moreover, the proposed combination of Eguchi et al. and Moore et al. fails to yield all of the features of independent Claim 1 and the claims that depend therefrom, and therefore, a *prima facie* case of obviousness has not been established under 35 U.S.C. § 103.

Accordingly, the Examiner is respectfully requested to withdraw the rejection of Claims 5, 7-9, and 13-17 and to allow these claims.

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Newly Added Claims

New Claims 50-60 have been added to further define the scope of the invention. These claims are allowable over the cited documents of record for at least the reasons set forth above with respect to Claim 1. In addition, independent Claims 50 and 56 are further allowable because the cited documents of record fail to disclose a conductive layer or discrete conductive elements positioned on an electrolyte layer that are disconnected from each other and from a voltage source.

Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below.

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Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

Dated: October 12, 2006

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